

**REMARKS**

This is a full and timely response to the Office Action mailed April 5, 2006.

By this Amendment, claim 1 has been amended to more particularly define the present invention. Further, new claim 2 has been added to further protect a specific embodiment of the present invention. Support for the claim amendments can be found throughout the specification and the original claim.

More specifically, support for the element “*coating a positive-type photosensitive composition on a photogravure plated roll to form a positive-type photosensitive film*” of the claims is found on page 22, line 24 to page 23, line 8, and page 35, lines 3-18 of the present specification. Support for the element “*exposing an image at the positive-type photosensitive film with a laser of infrared wavelength range*” of the claims is found on page 23, lines 17-19, page 35, line 26 to page 36, line 3 of the present specification. Support for the element “*developing the positive-type photosensitive film with alkaline developing liquid without burning after the coating step*” of the claims is found on page 23, lines 20-22, page 36, lines 8-17, page 24, line 7, and page 51, lines 23-24, of the present specification.

Additional support for the claim amendments can be found on pages 24-48, the Examples, page 49, lines 3-7, page 30, lines 26-29, page 31, line 27 to page 33, line 6 (specifically page 31, line 27 to page 32, line 2), page 33, lines 5-6, page 49, line 13 to page 50, line 3 (specifically page 49, lines 14, 23, 26-27 and page 50, lines 1-2) and page 49, lines 14-17 of the present specification.

In view of these amendments, Applicant believes that the pending claims are in condition for allowance. Reexamination and reconsideration in light of the above amendments and the following remarks is respectfully requested.

**Rejections under 35 U.S.C. §103**

Claim 1 is rejected under 35 U.S.C. §103(a) as allegedly being obvious over Sugano et al. (WO 02/41079 A2) in view of Takanezawa et al. (JP 03-255185) or Uruno et al. (JP 2002-180021). Further, claim 1 is rejected under 35 U.S.C. §103(a) as allegedly being obvious over Akiyama et al. (U.S. Patent 5,942,368). Applicant respectfully traverses these rejections.

To establish a *prima facie* case of obviousness, the cited references, either alone or in combination, must teach or suggest the invention as a whole, including all the limitations of the claims. Here, in this case, the cited references, either alone or in combination, fail to teach or

suggest each and every limitation newly presented in the amended claims with particular emphasis on the limitations “*consisting of*” and “*wherein the positive-type photosensitive composition is coated on a photogravure plated roll*”.

Sugano et al. discloses a “*positive type photosensitive epoxy resin composition and printed circuit board using the same*”. In contrast, amended claim 1 does not comprise an epoxy resin. In addition, Sugano et al. does not teach or suggest the claimed positive-type photosensitive composition being coated on a photogravure plated roll. Still further, as the Examiner acknowledges, Sugano et al. fails to teach or suggest the claimed adherence characteristic reforming agents.

To address this deficiency, the Examiner has cited Takanezawa et al. and Uruno et al. Takanezawa et al. discloses an adhesive for printed wiring board including acrylonitrile-butadiene rubber, alkylphenolic resin, epoxy resin, and crosslinking agent. Uruno et al. discloses an adhesive composition including epoxy resin, terpene phenolic resin (as a curing agent), and acrylic copolymer. Neither Takanezawa et al. nor Uruno et al. discloses the superior effects obtained from the addition of the component “adherence characteristic reforming agent” in the present invention.

By employing the claimed adherence characteristic reforming agent in combination with the claimed substances and pigments, the resulting positive-type photosensitive composition does not need to be subjected to a burning or heat treatment process after coating. Such an unexpected property is particularly useful in the process of making a photogravure plate where prior art positive-type photosensitive compositions require a burning or heat treatment process after coating. This superior property of the claimed positive-type photosensitive composition avoid the time and expense associated with the heat treatment process. Such a superior characteristic cannot be expected from the teachings of Takanezawa et al. and Uruno et al. since they only teach the use of the adhesive composition for improving the resistance to electrolytic corrosion, shelf stability and reliability (see the English abstract of Takanezawa et al.). As the Examiner already knows, a showing of superior and unexpected properties can rebut a *prima facie* case of obviousness. *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963).\

In addition, both Takanezawa et al. and Uruno et al. also fail to teach or suggest the claimed positive-type photosensitive composition being coated on a photogravure plated roll. Thus, the combined teachings of Sugano et al., Takanezawa et al. and Uruno et al. fails to disclose all the limitations of the claims.

With regard to Akiyama et al., the inventors of this patent employ quinonediazide compounds as the light-sensitive compounds of the positive-type light-sensitive composition (see column 22, lines 11-13, of Akiyama et al.). In contrast, the present invention does not comprise quinonediazide compounds. Further, the present invention does not employ titanium oxide even though the Examiner specifically notes its use in the Office Action.

Thus, in view of the amendments to claim 1, withdrawal of this rejection is respectfully requested.

**Rejection under Obviousness-Type Double Patenting**

Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claim 2 of U.S. Patent 6,911,300. Applicant respectfully traverses this rejection. However, in the interest of expediting the allowance of the present application, Applicant has submitted herewith a terminal disclaimer in accordance with U.S. practice. Thus, withdrawal of this rejection is respectfully requested.

With regard to new claim 2, Applicant believes that the cited references fail to teach or suggest all of the limitations of the claims. In particular, the cited references fails to teach or suggest a method for making a photogravure plate without a burning process (i.e. heat treatment process) after coating the positive-type photosensitive composition as well as coating a positive-type photosensitive composition on a photogravure plated roll to form a positive-type photosensitive film.

### CONCLUSION

For the foregoing reasons, all the claims now pending in the present application are believed to be clearly patentable over the outstanding rejections. Accordingly, favorable reconsideration of the claims in light of the above remarks is courteously solicited. If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the below-listed number.

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Respectfully submitted,

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